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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/986,191      | 11/07/2001  | Jian Ni              | PF256D1C1           | 4926             |

22195 7590 02/08/2005

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EXAMINER

MURPHY, JOSEPH F

ART UNIT

PAPER NUMBER

1646

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/986,191

Applicant(s)

NI ET AL.

Examiner

Joseph F Murphy

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 23-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23-40 is/are allowed.
- 6) ☒ Claim(s) 41-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Formal Matters***

Claims 23-54 are pending and under consideration.

### ***Response to Amendment***

Applicant's arguments filed 11/12/2004 have been fully considered but they are persuasive in part, for the reasons set forth below.

The rejection of claims 29, 38, 45, 52 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention for recitation of the term "fused to polyethylene glycol" has been obviated by Applicant's showing that the limitation has support in the Specification and is thus withdrawn.

The rejection of claims 41-54 stand rejected, under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention has been withdrawn.

New and remaining issues are set forth below.

### ***Claim Rejections - 35 USC §§ 101, 112, first paragraph***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 23-54 are rejected under 35 U.S.C. § 101 because they are drawn to an invention with no apparent or disclosed patentable utility. The instant application has provided a description of a protein. The instant application does not disclose the biological role of this protein or its significance. Applicant is directed to the Utility Examination Guidelines, Federal Register, Vol. 66, No. 4, pages 1092-1099, Friday January 5, 2001.

The Specification sets forth that the CCIII is homologous to known proteins. However, it is commonly known in the art that sequence-to-function methods of assigning protein function are prone to errors (Doerks et al. 1998). These errors can be due to sequence similarity of the query region to a region of the alleged similar protein that is not the active site, as well as homologs that did not have the same catalytic activity because active site residues of the characterized family were not conserved (Doerks et al. page 248, column 3, fourth and fifth paragraphs). Inaccurate use of sequence-to-function methods have led to significant function-annotation errors in the sequence databases (Doerks et al. page 250, column 1, third paragraph). Furthermore, Brenner (1999, Trends in Genetics 15:334-133) argues that accurate inference of function from homology must be a difficult problem since, assuming there are only about 1000 major gene superfamilies in nature, then most homologs must have different molecular and cellular functions. Finally, Bork et al. (1996, Trends in Genetics 12:425-427) add that the software robots that assign functions to new proteins often assign a function to a whole new protein based on structural similarity of a small domain of the new protein to a small domain of a

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known protein. Such questionable interpretations are written into the sequence database and are then considered facts.

After complete characterization, this protein may be found to have a patentable utility. This further characterization, however, is part of the act of invention and until it has been undertaken Applicant's claimed invention is incomplete. The instant situation is directly analogous to that which was addressed in *Brenner v. Manson*, 148 USPQ 689 (Sup. Ct., 1966), in which a novel compound which was structurally analogous to other compounds which were known to possess anticancer activity was alleged to be potentially useful as an antitumor agent in the absence of evidence supporting this utility. The court expressed the opinion that all chemical compounds are "useful" to the chemical arts when this term is given its broadest interpretation. However, the court held that this broad interpretation was not the intended definition of "useful" as it appears in 35 USC § 101, which requires that an invention must have either an immediately obvious or fully disclosed "real world" utility. The court held that:

"The basic quid pro quo contemplated by the Constitution and the Congress for granting a patent monopoly is the benefit derived by the public from an invention with substantial utility", "[u]nless and until a process is refined and developed to this point-where specific benefit exists in currently available form-there is insufficient justification for permitting an applicant to engross what may prove to be a broad field", and "a patent is not a hunting license", "[i]t is not a reward for the search, but compensation for its successful conclusion."

The instant claims are drawn to a polypeptide that has an as yet undetermined function or biological significance. Until some actual and specific significance can be attributed to the protein identified in the specification as CCIII, the instant invention is incomplete. In the absence of knowledge of the natural substrate or biological significance of this protein, there is no immediately obvious patentable use for it. To employ a protein of the instant invention in the

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identification of substances that inhibit its activity is clearly to use it as the object of further research that has been determined by the courts to be a non-patentable utility. Since the instant specification does not disclose a "real world" use for CCIII then the claimed invention is incomplete and, therefore, does not meet the requirements of 35 USC § 101 as being useful.

Claims 23-54 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

In addition, claims 41-54 stand rejected under 35 U.S.C. 112, first paragraph, because the specification, which is enabling for a full-length protein of SEQ ID NO: 2, does not reasonably provide enablement for a fragment of 30-50 contiguous amino acids of SEQ ID NO: 2, for reasons of record set forth in the Office Action of 8/11/2004. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

The rejection of record set forth that the claims are drawn to a fragment of the amino acid sequence of SEQ ID NO: 2. Claims 41-54 are overly broad since insufficient guidance is provided as to which of the myriad of variant polypeptides will retain the characteristics of CCIII. Applicant argues that the skilled artisan, and that the skilled protein chemist or molecular biologist, enlightened by the teachings of the present specification, is more than capable of routinely determining whether a polypeptide encompassed by the claims can be used as an immunogen to produce antibodies to CCIII and/or retains the biological activity of CCIII. However, the claims as written do not set forth a limitation wherein the peptides must server as

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an immunogen for CCIII, nor do they set forth a limitation wherein the peptide retains any particular activity of CCIII. Since detailed information regarding the structural and functional requirements of the encoded polypeptide is lacking, it is unpredictable as to which variations, if any, meet the limitations of the claims. Applicant argues that the specification sets forth that polypeptide fragments of CCIII can be constructed and then tested for functionality. However, Applicant is required to enable one of skill in the art to make and use the claimed invention, while the claims encompass polypeptides which the specification only teaches one skilled in the art to test for functional fragments. It would require undue experimentation for one of skill in the art to make and use the claimed fragments, since the skilled artisan would have to first make polypeptide fragments of CCIII, then test for function. Because the amino acid sequence of a polypeptide determines its structural and functional properties, and predictability of which amino acids can be substituted is extremely complex, accurate predictions of a polypeptide's structure from mere sequence data are limited. Thus, since Applicant has only taught how to test for polypeptide fragments of CCIII, and has not taught how to make polypeptide fragments of CCIII, it would require undue experimentation of one of skill in the art to make and use the claimed fragments.

### ***Conclusion***

Claims 23-54 are rejected.

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***Advisory Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Murphy whose telephone number is (571) 272-0877. The examiner can normally be reached Monday through Friday from 7:30 am to 5:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tony Caputa, can be reached on (571) 272-0829.

The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph F. Murphy, Ph. D.  
Patent Examiner  
Art Unit 1646  
January 24, 2005

  
JOSEPH MURPHY  
PATENT EXAMINER